REMARKS

Reconsideration of this Application is respectfully requested.

Claim 19 is pending.

Based upon the following Remarks, the applicants respectfully request the Examiner reconsider all outstanding objections and rejections, and that they be withdrawn.

Priority:

The Examiner alleges that the effective filing date of the instant application is August 1, 1995, asserting that U.S. Patent Applications 07/970,540 (abandoned), 07/958,870 (U.S. 5,529,914), 08/022,687 (U.S. 5,410,016), 08/336,393 (U.S. 5,820,882) and 08/379,848 (U.S. 5,626,863) do not contain any subject matter regarding a biocompatible mixture containing at least one ionically crosslinkable component and at least one covalently crosslinkable component.

Applicants respectfully traverse. Attached as Exhibit 1 is a claim chart setting forth the elements of claim 19, the parent application in the continuity chain, and location of support for the various elements within each of the specifications.

In order for a later-filed application to properly claim priority back to parent applications, the invention disclosed in the later-filed application must be disclosed in the prior applications, which priority is being sought. *Transco Products, Inc., v. Performance Contracting, Inc.*, 38 F.551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The instant application is a Continuation of U.S. application 09/910,663, filed July 19, 2001, now abandoned, which is a Continuation of U.S. application 08/510,089, filed on August 1, 1995, now abandoned, which is a CIP of U.S. application 07/958,870, filed October 7, 1992, Patent No. 5,529,914, which is a CIP of U.S. application 07/870,540, filed April 20, 1992, now abandoned, which is a CIP of U.S. application 07/843,485, filed February 28, 1992, now abandoned.

U.S. application 08/510,089 is also a CIP of U.S. application 08/379,848, filed January 27, 1995, Patent No. 5,626,863, which is a Continuation of U.S. application 08/022,687, filed March 1, 1993, Patent No. 5,410,016, which is a CIP of U.S. application 07/843,485, filed on February 28, 1992, now abandoned. U.S. application 08/510,089 is also a CIP of U.S. application 08/336,393, filed November 10, 1994, Patent No. 5,820,882, which is a Continuation of U.S. application 07/598,880, filed October 15, 1990, now abandoned.

Based upon the above chain of priority, which this application claims, the instant specification should be given the effective filing date, at the latest, of February 28, 1992. As outlined in Exhibit 1, each claim limitation of claim 19 is supported by the specifications of the priority applications. Applicants have indicated the location(s) of each limitation of claim 19. As such, the instant application is entitled to an effective filing date of February 28, 1992.

Applicants respectfully request the effective filing date of the instant application be recognized, at the latest, to be February 28, 1992, in view of the above remarks and Exhibit 1.

Citing Prior Applications:

The Examiner has pointed out that the patent numbers of those applications, which have matured into U.S. Patents, should be in the first paragraph of the instant application and abandonments should also be noted in the same place.

Applicants herewith submit an amendment to the first paragraph of the instant application noting the status of the applications listed. Further, the chain of priority has also been amended to clearly set forth the continuity.

Rejection under 35 U.S.C. § 102 (b):

Claim 19 stands rejected under 35 U.S.C. §102(b) as being anticipated by Nisshinbo Industries Inc. EP 0 555 980.

Applicants respectfully traverse.

In order for a reference to be a proper 35 U.S.C. §102(b) prior art reference, the invention must have been "patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent." The Nisshinbo reference was first published on August 18, 1993 and was patented on October 23, 1996. The instant application has an effective filing date, at the latest, of February 28, 1992, which pre-dates the Nisshinbo reference. Therefore, the Nisshinbo reference is not prior art and cannot anticipate the instant application.

Rejection under 35 U.S.C. § 102(e):

Claim 19 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Desai, et al (U.S. 5,334,640), Desai, et al. (U.S. 5,550,178), Soon-Shiong, et al. (U.S. 5,705,270), Soon-Shiong, et al. (U.S. 5,700,848), Gunther, et al. (U.S. 5,736,595), Soon-Shiong, et al. (U.S. 5,837,747), Soon-Shiong, et al. (U.S. 5,846,530), or Mathiowitz, et al. (U.S. 5,985,354).

Applicants respectfully traverse.

The references cited by the Examiner are all patents and therefore fall under 35 U.S.C. §102(e)(2). In order for a reference to be a proper 35 U.S.C. §102(e)(2) prior art reference, the invention must have been described in . . . "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English

language. However, references based on international applications that were filed prior to November 29, 2000 are subject to the former (pre-AIPA) version of 35 U.S.C. §102(e) as set forth below. MPEP §706.02(a).

Former 35 U.S.C. §102 (e): "A person shall be entitled to a patent unless . . . the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent." See MPEP §706.02(a).

Patents issued directly, or indirectly, from international applications filed before November 29, 2000, may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000. Thus, the 35 U.S.C. 102(e) date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371 (c)(1), (2) and (4), or the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application. MPEP §706.02(a). International applications, which were filed prior to November 29, 2000, may not be used to reach back (bridge) to an earlier filing date through a priority benefit claim for prior art purposes under 35 U.S.C. §102(e). MPEP §706.02(a).

Soon-Shiong, et al. Patents:

Since the four Soon-Shiong, et al. patents (U.S. 5,700,848; 5.705,270; 5,837,747; 5,846,530) issued directly, or indirectly, from an international application (PCT/US92/09364; filed October 29, 1992) filed before November 29, 2000, the pre-AIPA 35 U.S.C. §102(e) applies. As such, the earliest effective filing dates for the three Soon-Shiong patents listed above would be October 29, 1992 based on the 35 U.S.C. §371 compliance date. Although the international application claims priority to a CIP application (U.S. application 07/784,267; filed October 29, 1991), the four above-listed patents cannot use the international application to bridge the gap. MPEP 706.02(a).

Since the instant application has an effective filing date, at the latest, of February 28, 1992, which is prior to the four Soon-Shiong, et al. patents' effective filing date, they are not prior art and therefore cannot anticipate the instant application.

Gunther, et al. Patent:

With respect to the Gunther, et al. patent (U.S. 5,736,595), it would be treated the same way as the Soon-Shiong patents because it is a patent based on an international application filed before November 29, 2000. Since, the pre-AIPA 35 U.S.C. §102(e) would apply, the effective filing date for the patent would either be the filing date in the United States or when the 35 U.S.C. §371 requirements were met. The Gunther, et al. patent has a 35 U.S.C. §371 date of November 3, 1995, which is also the 35 U.S.C. §102(e) date, which is after the effective filing date for the instant application. Therefore, the Gunther, et al. patent is not prior art and thus, cannot anticipate the instant application.

Desai, et al Patents and Mathiowitz, et al. Patent:

With respect to the Desai, et al patents (U.S. 5,334,640 and 5,550,178) and Mathiowitz, et al. patent (U.S. 5,985,354), the proper 35 U.S.C. §102(e) to use would be the current statute. Thus, the effective date for the Desai, et al. patents is April 8, 1992 (the application filing date and earliest claim to priority) and the effective date for the Mathiowitz, et al. patent is June 7, 1995 (the application filing date). Since both effective filing dates for 35 U.S.C. §102(e) purposes are after the effective filing date of the instant application, the three patents are not prior art. Therefore, the three patents cannot anticipate the instant application.

Applicants respectfully request reconsideration and withdraw of this ground of rejection because the cited patents are not prior art and thus, cannot and do not anticipate the instant application.

Rejection under Double Patenting:

Claim 19 stands rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 19 of prior U.S. Patent 5,334,640. The Examiner asserts that this rejection is a double patenting rejection because of a common inventor or assignee.

Claim 19 also stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37-58 of U.S. 5,334,640 C1.

Applicants respectfully traverse. The filing date of U.S. 5,334, 640 (hereinafter "the '640 patent") is April 8, 1992. The instant application has a priority date of February 28, 1992. The instant application pre-dates the '640 patent. Further there is no art properly cited against the instant application; thus, the claims of the pending application are patentable and in condition for immediate allowance. This is a situation where an interference should be declared. The applicants are the senior party as they were the first to invent.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office action and, as such, the present application is in condition for allowance. Applicants wish to expedite the prosecution process and if the Examiner believes, for any reason that personal communication will help expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,
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PATENT TRADEMARK OFFICE

Our Ref.: 354848-20001							
Pending Claims of U.S. 10/743,687	**Support Within 08/510,089 Application's Specification (08-01-95) CPAs (05-19-98 & 01-28-00)**	**Support Within 08/379,848 (U.S. 5,626,863) Application's Specification (01-27-95)**	**Support Within 08/022,687 (U.S. 5,410,016) Application's Specification (03-01-93)**	**Support Within 07/843,485 Application's Specification (02-28-92)**	**Support Within 07/958,870 (U.S. 5,529,914) Application's Specification (10-07-92)**	**Support Within 07/870,540 Application's Specification (04-20-92)**	**Support Within 08/336,393 (U.S. 5,820,882) Application's Specification (11-10-94)**
19. A crosslinkable biocompatible mixture comprising:	page 11, lines 16-18; page 13, lines 15-20; page 18, line 7; page 26, line 24-26; Ex. 18, page 69	column 3, lines 65-67; column 4, lines 12-14; column 4, line 63 to column 5, line 4; column 5, lines 58-60; column 7, lines 47-50; Ex. 11, column 20, line 61 to column 21, line 15; Ex. 12, column 21, line 15 to column 25, line 22	column 4, lines 14-17 and 29-31; column 5, lines 15-23; column 6, lines 11-16; column 8, lines 8-12; Ex. 11, column 21, lines 47-68; Ex. 12, column 22 to column 26, line 17	page 15, lines 9-12; page 20, lines 30-35; page 22, lines 15-18 and lines 29-32	column 5, lines 42-44; column 6, lines 12-17; column 7, lines 25-27; column 13, lines 15-27; Ex. 10, column 19	page 12, lines 5-10; page 13, lines 6-14; page 21, line 19 to page 22, line 9; Ex. 10, page 33	column 4, lines 37-39; column 5, lines 62-65
at least one ionically crosslinkable component; and	page 30, lines 8-12; page 31, lines 8-18; page 130, lines 5-21	column 8, lines 9-16 and 41-47; Ex. 16, column 26, lines 41-60	column 8, lines 40-48; column 9, lines 6-13; Ex. 16, column 27, lines 31-52	page 16, lines 19-22; page 27, lines 2-5	column 11, lines 19-28	page 18, lines 11-22; page 21, lines 5-17	column 4, line 44, 46, 50-51; column 5, line 48, 50-52
at least one covalently crosslinkable component.	page 28, line 15 to page 30, line 20; page 31, lines 8-29; page 32, line 1 to page 37, line 19; page 92, line 25 to page 104, line 14; page 130, lines 5-21; Figs. 1, 2, 3	column 8, lines 9-16 and 41-47; Ex. 16, column 26, lines 41-60	column 8, lines 40-48; column 9, lines 6-13; Ex. 16, column 27, lines 31-52	page 13, lines 6-10; page 15, lines 8-24; page 16, lines 19-22; page 20, lines 15-20; page 24, lines 19 to page 25, line 2; page 26, line 33 to page 27, line 11; Fig.1	column 11, lines 19-28	page 16, lines 23-26; page 18, lines 11-22; page 21, lines 5-17	column 4, line 44, 46, 50-51; column 5, line 48, 50-52; column 6, lines 1-3; claim 2 and claim 3
wherein the ionically crosslinkable component is selected from a polysaccharide, a polyanion, or polycation.	page 28, line 15 to page 30, line 20; page 31, lines 8-29; page 87, line 5 to page 88, line 13; page 130, lines 5-21	column 8, lines 9-16 and 41-47; Ex. 15, column 26, lines 15-39; Ex. 16, column 26, lines 41-60	column 8, lines 40-48; column 9, lines 6-13; Ex. 15, column 27, lines 6-30; Ex. 16, column 27, lines 31-52	page 16, lines 19-22; page 26, line 33 to page 27, line 11	column 11, lines 19-28	page 16, lines 23-26; page 18, lines 11-22; page 21, lines 5-17	column 4, lines 42-54; column 5, lines 42-45; column 8, lines 15-21; claim 7